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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,920	05/29/2001	Mathew Thankachan	SMQ-052 (P5699)	7547

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EXAMINER	
BAYARD, DJENANE M	

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/867,920	THANKACHAN, MATHEW	
	Examiner	Art Unit	
	Djenane M. Bayard	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to amendment filed on 6/29/05 in which claims 1-24 are pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

3. As per claim 1, Applicant argues, "Chernin fails to teach retrieving data indicated by the user input parameter from selected email message in the active storage location". However, the claim language fails to recite such limitation. Furthermore, as taught by the second paragraph on page 5 of the specification, the storage location can also be located on the server side "the storage locations are remotely located to the electronic device 20. The remote storage locations 32, 34 and 36 are connected to the mail server 30" (See Specification, page 5, second paragraph). The active storage location is only the location displayed to the user on the electronic device. Therefore, applicant's argument is not persuasive

As per claim 11, Jamali clearly teaches deleting duplicative data from a document. Applicant's claim invention is merely the removal of duplicate data in a document.

As per claim 12, 18 and 22, Applicant argues that Special Edition in view of Chernin and further in view of Elson fails to teach "searching the storage locations with the search feature, the search feature copying less than all the data in selected email messages". However, Chernin clearly teaches wherein " email search display to be generated on the screen of the computer"..."wherein the e-mail search is completed the results are displayed and each items in the listing of the results is provided in the form of a Hypertext link"... " Mouse-clicking (or otherwise selecting) one of the hypertext links causes the preferred software to generate a display of the complete e-mail message associated with that hypertext link" (See col.35, lines 1-20).

Furthermore, Applicant argues that Elson fails to teach "copying less than all of the data in the selected email message in the storage locations". However, claim 12 and 18 teaches fails to teach such limitation. Claims 12 and 18 teaches "search feature copying less than all the data in a selected email message containing data referenced by said parameter; inserting the copied data from said selected email message and a hyperlink to said selected email message into a new document", thus copying the into the document not the storage location.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,643,694 to Chernin.

a. As per claim 1, Special Edition Using Microsoft Outlook 2000 teaches an electronic device, said electronic device executing an email application, a method comprising the steps of: providing a plurality of storage locations for storing email messages, said email messages including a header and a body, said storage locations accessible by said email application, said email application designating one of said storage locations as an active storage location (See page 3 and figure 18.7); providing a search feature for use with said email application, said search feature including a user-input parameter, said search feature using said parameter to

retrieve data from said email messages (See page 17 and 18 and figure 18.16); searching said designated active storage location with said search feature (See page 3 and figure 18.7); However, Special Edition Using Microsoft Outlook 2000 fails to teach retrieving data indicated by said parameter from selected email messages in said active storage location; and creating a new document containing data retrieved from said messages.

Chernin teaches retrieving data indicated by said parameter from selected email messages in said active storage location; and creating a new document containing data retrieved from said messages (See col. 34)

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate retrieving data indicated by said parameter from selected email messages in said active storage location; and creating a new document containing data retrieved from said messages as taught by Chernin in the invention of Microsoft Outlook in order to display the results of the e-mail search (See col. 34, lines 64-67)

b. As per claim 3, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature searches all of said plurality of storage locations for storing email messages (See page 3 and figure 18.7).

c. As per claim 4, Special Edition Using Microsoft Outlook 2000 teaches searching the header of said email messages for data referenced by said parameter; searching the body of said email messages for data referenced by said parameter; and searching any email attachments for data referenced by said parameter (See page 4).

d. As per claim 5, Special Edition Using Microsoft Outlook 2000 in view of Chernin teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook fails to teach wherein said new document is in Hypertext Markup Language (HTML) format.

Chernin teaches wherein the document is in Hypertext Markup Language (HTML) (See col. 34).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the document is in Hypertext Markup Language (HTML) as taught by Chernin in the claimed invention of Special Edition Using Microsoft Outlook 2000 in order to display the results of the e-mail search (See col. 34, lines 64-67),

e. As per claim 6, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature is integrated with said email application (See page 1).

f. As per claim 7, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature is a stand-alone application (See page2).

g. As per claim 8, Special Edition Using Microsoft Outlook 2000 teaches wherein the email data in said new document is sorted by date of creation of the email message from which the data was retrieved (See page 11).

h. As per claim 9, Special Edition Using Microsoft Outlook 2000 teaches wherein the email data in said new document is sorted by date of receipt of the email message from which the data was retrieved (See page 14).

i. As per claim 10, Special Edition Using Microsoft Outlook 2000 teaches wherein the email data in said new document is sorted by sender (See page 10).

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,643,694 to Chernin as applied to claim 1 above, and further in view of U.S. Patent Application No 2003/0163468 to Freeman et al.

a. As per claim 2, Special Edition Using Microsoft Outlook 2000 in view of Chernin teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook 2000 in view of Chernin fails to teach forwarding said new document to a user of said electronic device.

Freeman et al teaches a document stream operating system. Furthermore, Freeman et al teaches forwarding new document to a user of said electronic device (See page 4, paragraph [0051]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forwarding said new document to a user of said electronic device as

taught by Freeman et al in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Chernin in order to organize data unit (See page 2, paragraph [0019]).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of in view of U.S. Patent No. 6,643,694 to Chernin and further in view of U.S. Patent No. 6243501 to Jamali.

a. As per claim 11, Special Edition Using Microsoft Outlook 2000 in view of Chernin teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook 2000 in view of Chernin fails to teach wherein said new document is forwarded to a user after deleting the email data that is duplicative.

Jamali teaches wherein said new document is forwarded to a user after deleting the email data that is duplicative (See col. 2, lines 30-40).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein said new document is forwarded to a user after deleting the email data that is duplicative as taught by Jamali in view of Special Edition Using Microsoft Outlook 2000 in view of Chernin in order to increase the amount of resources available for storing document (See col. 2, lines 30-40).

8. Claim 12-13, 15-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of in view of U.S. Patent No. 6,643,694 to Chernin and further in view of U.S. Patent No. 6,216,122 to Elson.

a. As per claims 12 and 18, Special Edition Using Microsoft Outlook 2000 teaches providing a storage locations for storing email messages, said email messages including a header and a body, said storage locations accessible by said email application (See page 3 and figure 18.7); providing a search feature for use with said email application, said search feature including a user-input parameter, said search feature using said parameter to reference data in said email messages (See page 1); However, Special Edition Using Microsoft Outlook 2000 fails to teach searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by said parameter; inserting the copied data from said selected email message and a hyperlink to said selected email message into a new document and plurality of storage location.

Chernin et al teaches "e-mail search display to be generated on the screen of the computer" and wherein "the e-mail search is completed the results are displayed ... and each item in the listing of the results is provided in the form of a Hypertext link" (See col. 34 and col. 35, lines 1-20)

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by said parameter; inserting the copied data from said selected email message and a hyperlink to said selected email message into a new document as taught by Chernin in the claimed invention of Special Edition Using Microsoft Outlook 2000 in order to display the results of a search

operation initiated by a user (See col. 2, lines 42-50). However, Special Edition Using Microsoft Outlook 2000 in view of Chernin fails to teach a plurality of storage locations.

Elson et al teaches an electronic mail indexing folder having a search scope and interval. Furthermore, Elson et al teaches a plurality of storage locations (See 3, lines 27-44).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a plurality of storage locations in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Plow et al in order to provide continual access to the search result without having to specify the search each time the user wants to see the result (See col. 1, lines 55-58).

b. As per claims 13 and 19, Special Edition Using Microsoft Outlook 2000 teaches searching the header of said email messages for data referenced by said parameter; searching the body of said email messages for data referenced by said parameter; and searching any email attachments for data referenced by said parameter (See page 4).

c. As per claim 15, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature is integrated with said email application (See page 1).

b. As per claim 16, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature is a stand-alone application (See page 2).

9. Claims 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of in view of U.S. Patent No. 6,643,694 to Chernin and further in view of U.S. Patent No. 6,216,122 to Elson as applied to claims 12 and 18 above, and further in view of U.S. Patent Application No. 2003/0131006 to Monahan et al.

a. As per claims 14 and 20, Special Edition Using Microsoft Outlook 2000 in view of Chernin and further in view of Elson teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook 2000 fails to teach wherein said new document is in Hypertext Markup Language (HTML) format.

Monahan teaches a method and system for communicating selected search results between first and second users over a network. Furthermore, Monahan teaches wherein the search result set page may be an HTML document (See page 4, paragraph [0054]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the document is in Hypertext Markup Language (HTML) as taught by Monahan in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Chernin and further in view of Elson in order to communicate the search result to an HTML enabled e-mail client or browser that executes in a client machine (See page 4, paragraph [0054]).

10. Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,643,694 to Chernin and further in view of U.S. Patent No. 6,216,122 to Elson as applied to claims 12 and

21 above and further in view of U.S. Patent No. 6243501 to Jamali.

a. As per claim 17 and 21, Special Edition Using Microsoft Outlook 2000 in view of Plow et al and further in view of Elson et al teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook 2000 in view of Plow et al and further in view of Elson et al fail to teach wherein said new document is forwarded to a user after deleting the email data that is duplicative.

Jamali teaches wherein said new document is forwarded to a user after deleting the email data that is duplicative (See col. 2, lines 30-40).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein said new document is forwarded to a user after deleting the email data that is duplicative as taught by Jamali in view of Special Edition Using Microsoft Outlook 2000 in view of Chernin and further in view of Elson in order to increase the amount of resources available for storing document (See col. 2, lines 30-40).

11. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,216,122 to Elson and further in view of U.S. Patent Application No. 2002/0138474 to Lee.

a. As per claim 22, Special Edition Using Microsoft Outlook 2000 teaches providing a plurality of storage locations for storing email messages, said email messages including a header and a body, said storage locations accessible by said email application (See page 3 and figure

18.7); providing a search feature for use with said email application, said search feature including a user-input parameter, said search feature using said parameter to reference data in said email messages (See page 4); searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by said parameter inserting the copied data from said selected email message into a new document (See page 1); However, Special Edition Using Microsoft Outlook 2000 fails to teach a plurality of storage locations and caching a copy of said new document and cross-referencing said new document copy and said search request in an index of cached documents.

Elson et al teaches an electronic mail indexing folder having a search scope and interval. Furthermore, Elson et al teaches a plurality of storage locations (See 3, lines 27-44).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a plurality of storage locations in the claimed invention of Special Edition Using Microsoft Outlook 2000 in order to provide continual access to the search result without having to specify the search each time the user wants to see the result (See col. 1, lines 55-58). However, Special Edition Using Microsoft Outlook 2000 in view of Elson fails to teach caching a copy of said new document and cross-referencing said new document copy and said search request in an index of cached documents.

Lee teaches wherein the search results, the underlying document listed in the search results, as well as the search criteria maybe saved in local or remote memory units (See page 3, paragraph [0025]).

It would have bee obvious to one with ordinary skill in the art at the time the invention was made to incorporate caching a copy of said new document and cross-referencing said new

document copy and said search request in an index of cached documents as taught by Lee in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Elson in order to compile the search result for storage, display or other output (See page 2, paragraph [0020]).

b. As per claim 23, Special Edition Using Microsoft Outlook 2000 in view of Elson et al teaches the claimed invention as described above. However, Special Edition Using Outlook 2000 in view of Elson et al fails to teach searching said index for cached documents cross-referenced to a search request; retrieving a cached document responsive to said search request; searching said storage locations for additional responsive data in email messages stored after a last modification date of said responsive cached document; updating said cached document with said responsive data so that only non-duplicative data is inserted into said cached document; and changing said modification date of said cached document to reflect the date of said search request.

Lee teaches searching said index for cached documents cross-referenced to a search request; retrieving a cached document responsive to said search request; searching said storage locations for additional responsive data in email messages stored after a last modification date of said responsive cached document; updating said cached document with said responsive data so that only non-duplicative data is inserted into said cached document; and changing said modification date of said cached document to reflect the date of said search request (See page 3, paragraph [0024-0026]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate searching said index for cached documents cross-referenced to a search

request; retrieving a cached document responsive to said search request; searching said storage locations for additional responsive data in email messages stored after a last modification date of said responsive cached document; updating said cached document with said responsive data so that only non-duplicative data is inserted into said cached document; and changing said modification date of said cached document to reflect the date of said search request as taught by Lee in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Elson in order to compile the search result for storage, display or other output (See page 2, paragraph [0020]).

12. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,216,122 to Elson and further in view of U.S. Patent Application No. 2002/0138474 to Lee as applied to claim 23 above, and further in view of U.S. Patent Application No. 2003/0002488 to Hyakutake.

a. As per claim 24, Special Edition Using Microsoft Outlook 2000 in view of Elson et al and further in view of Lee teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook 2000 in view of Elson et al failed to teach wherein said cached document is forwarded to a user.

Hyakutake teaches wherein said cached document is forwarded to a user (See page 8, paragraph [0153]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein said cached document is forwarded to a user as taught by

Hyakutake in the claimed invention of Special Edition using Microsoft Outlook 2000 in view of Elson et al and further in view of Lee in order to display the search result (See page 8, paragraph [0153]).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,745197 to McDonald teaches a system and method for efficiently processing messages stored in multiple message stores.

U.S. patent Application No. 2002/0194162 to Rios et al teaches a method and system for expanding search criteria for retrieving information items.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard

Patent Examiner

RUPAL DHARIA
TECHNOLOGY PATENT EXAMINER